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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,577	01/15/2002	James J. Davies	CHA920010007US1	4673
23550	7590	05/04/2005	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC 3 E-COMM SQUARE ALBANY, NY 12207			NGUYEN, TAN D	
		ART UNIT		PAPER NUMBER
		3629		

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/047,577	DAVIES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 February 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 115702
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/16/2005 has been entered.

### ***Response to Amendment***

The amendment filed 2/16/2005 has been entered.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-3 are directed to a method and program product for "determining conflicting assignments of tasks of business process", which is not within one of the classes of invention set forth in § 101.

The method and program product for "determining conflicting assignments of tasks of business process" comprising the steps of:

- "(a) transforming ...
- (b) inputting ...
- (c ) dividing the business .... ,
- (d) identifying for each of the component ....,
- (e) associating at least one of ..., and
- (f) determining whether each associated component task is a conflicting task ....."

as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The method and program product for "determining conflicting assignments of tasks of business process" comprising the steps of (a)-(f) as shown are merely:

- (1) an abstract idea and
- (2) does not reduce to a practical application in the technological arts (failing to show manipulation/calculation/determination of input data by computer or computing network or computing means to produce a separate/different result) and are therefore found to be non-statutory. Applicant has amended claim 1 to include steps (a) and (b) with the objective to overcome the 101 rejections; however, this is insufficient since it's not clear the relationship of steps (a), (b) to the rest of the claim and there is no manipulation/determination/calculation step using a computer processor. There is a determining step (f) but it's not limited to a computer processor.

See (1) *In re Schrader* 22 F.3d 290, USPQ2d 1455 (CCPA), or (2) *In re Musgrave*, 167 USPQ 280 (CCPA 1970), or (3) *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or (4) *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or (5) *In re Johnston*, 183 USPQ 172.

***Claim Rejections - 35 USC § 112***

**4. Claims 1-3, 4-6, 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

(1) claim 1 is vague and indefinite because the preamble calls for “determining conflicting assignments of tasks” but there is no discussion of “assignments of tasks” in the body of the claim.

(2) In claim 1, step (a) of “transforming the business process into ... signals and data” is vague and indefinite since “process” is an abstract language and cannot be transformed into visible items such as signals or data. It’s recommended that language such as information or data to be inserted after the term process to clarify this issue and overcome the rejection.

(3) In claim 1, it’s not clear the relationship of “electronic signals and data representative of the business process” to the body of the claims since there is no discussion of the signals and data and data storage mechanism in the body of the claim.

(4) In claim 1, it’s not clear how step (d) “identifying” is carried out to fulfill the final step (f).

(5) It's not clear how the last step (f) of "determining whether" can be carried out when step (e) of "associating at least 1 (read over just 1) component task with a person". How can one compare 2 tasks if only 1 task is associated or assigned is available. One cannot compare one item to the same item. Furthermore, it's not clear the relationship of the "person" to the remaining of the claim. It appears from page 2, 1<sup>st</sup> paragraph of the specification, that this person is critical since the goal is to avoid appointing/assigning this same person to 2 jobs that are conflicting to each other, i.e. filling out a purchase order and approving the purchase order. Therefore, the current language in the last step is vague and confusing. Applicant needs to show an example in the specification of how this last step is carried out?

(6) Claim 2 is vague and indefinite because it's written in a passive state. Changing the claim language to positive active state is recommended for a method claim.

(7) Claim 3 recites the limitation "assigning, network activities, and administrative signatures" in the claim. There is insufficient antecedent basis for this limitation in the claim or any discussion related to these 3 options in claim 1.

(7) Claim 4 is vague and indefinite because the preamble calls for "determining conflicting assignments of tasks" but there is no discussion of "assignments of tasks" in the body of the claim.

(8) It's not clear how the last element (f) of "means for determining whether" can be carried out when element (e) of "means for associating at least 1 (read over just 1) component task with a person". How can one compare 2 tasks if only 1 task is

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associated or assigned is available. One cannot compare one item to the same item. Furthermore, it's not clear the relationship of the "person" to the remaining of the claim. It appears from page 2, 1<sup>st</sup> paragraph of the specification, that this person is critical since the goal is to avoid appointing/assigning this same person to 2 jobs that are conflicting to each other, i.e. filling out a purchase order and approving the purchase order. Therefore, the current language in the last step is vague and confusing. Applicant needs to show an example in the specification of how this last step is carried out?

(9) Claim 7 is vague and indefinite because the preamble calls for "determining conflicting assignments of tasks" but there is no discussion of "assignments of tasks" in the body of the claim.

(10) It's not clear how the last program code (f) of "program code configured to determine whether" can be carried out when previous program code (e) of "program code configured to associate at least 1 (read over just 1) component task with a person". How can one compare 2 tasks if only 1 task is associated or assigned is available. One cannot compare one item to the same item. Furthermore, it's not clear the relationship of the "person" to the remaining of the claim. It appears from page 2, 1<sup>st</sup> paragraph of the specification, that this person is critical since the goal is to avoid appointing/assigning this same person to 2 jobs that are conflicting to each other, i.e. filling out a purchase order and approving the purchase order. Therefore, the current language in the last step is vague and confusing. Applicant needs to show an example in the specification of how this last step is carried out?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**10. Claims 1-2, 4-6, 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by ANDERSON et al (US 2002/0120482).**

As for independent method claim 1, ANDERSON et al discloses a method for business controlling by determining conflicting assignments of tasks (duties, or activities) of a business process including use of a computer system comprising:

- (a) transforming the business process into computer processor readable electronic signals and data {see Fig. 1, SAP (profile, tables), Tool (PC), SOD Matrix and results};
- (b) inputting the computer processor readable electronic signals and data into a data storage mechanism {see 0023, 0024 "database"},
- (c) dividing the business process into component tasks (activities, duties) on the computer {see "separations of duties" or "SOD" on 0026];
- (d) identifying for a component task any other component task that conflicts with the component task on the computer system {see 0026; 0032};
- (e) associating at least one component task with a person involved in the business process {see [0026 "a list of users and assigned profiles"]};
- (f) determining whether each associated component task is a conflicting task {see Fig. 2C "SOD Conflicts", [0022], [0026]}. As for the step of "comparing" the task to identify the conflict task, this is inherently included in the process of ANDERSON et al in view of [0026], [0043 "comparators" for comparing] in order to achieve the result of determining the "SOD conflict".

**As for dep. claim 2** (part of 1), the further limitation of carrying out the previous steps by a computer software program is taught on Fig. 1 "PC program".

**As for independent Apparatus claim 4**, which is basically the system to carry out the method of claim 1 above, with "means for" instead of "step of", it's rejected over the "means for" to carryout the equivalent step as shown in the rejection of claim 1 above.

**As for dep. claim 5** (part of 4), with deals with the identifying conflicting tasks parameter, i.e. using a matrix, this is shown in {[0026 "separation of duties (SOD) matrix"]}.

**As for dep. claim 6** (part of 4), with deals with the means for determining parameter, i.e. by comparing, this is inherently included in the process of ANDERSON et al in view of [0026], [0043 "comparators" for comparing] in order to achieve the result of determining the "SOD conflict".

**As for independent Product claim 7**, which is basically the computer program product to carry out the method of claim 1 above, with "program code configured to" carry out the same step as in claim 1 above, it's rejected over the "program" to carryout the equivalent step as shown in the rejection of claim 1 above, see Also Fig. 1 "PC program", [0043, 0044].

**As for dep. claims 8-9** (part of 4), which have similar limitations as in dep. claims 5-6 above, they are rejected for the same reasons set forth in dep. claims 5-6 above.

11. **Claims 1-3, 4-6, 7-9 are rejected (2<sup>nd</sup>) under 35 U.S.C. 103(a) as being unpatentable over LUSA, Article “1991 Network .. Block” of Mar. 1991, alone or further in view of ANDERSON et al.**

**As for independent method claim 1, LUSA fairly discloses a method for business controlling by determining conflicting assignments of tasks (duties, or activities) of a business process comprising:**

(c ) dividing the business process into component tasks (activities, duties) on the computer {see page 3, see footnote (1), (2), (4)}; .  
(d) identifying for a component task any other component task that conflicts with the component task on the computer system {see page 3 footnotes (2), (3);  
(e) associating at least one component task with a person involved in the business process {see page 3, footnotes (3) and (4)};  
(f) determining whether each associated component task is a conflicting task {see page 3, footnotes (1), (3) and (4)}. LUSA teaches the claimed invention except for steps (a), (b) and carrying out the steps using a computer system. In other word, LUSA teaches the claimed invention except for automating the steps using computer system. Since making automatic or automate from manual operation using computer system is an obvious modification to a an artisan, see In re Venner, 120 USPQ 192, CCPA 1958, it would have been obvious to automate the steps of LUSA using computer system, absent evidence of unexpected results. As for steps (a) and (b), these are inherently included when carrying out the invention of LUSA using a computer system.

In a similar process for controlling business by determining conflicting assignments of tasks (duties, or activities) of a business process including use of a computer system, ANDERSON et al teaches the use of inputting these steps into a computer system and generate a SOD matrix to identify conflicted assignment {see Fig. 1, 2, [0026, 0027, 0032]}. It would have been obvious to modify the process of LUSA by using computing system with independent programming tool as taught by ANDERSON et al for effectively analyzing business SOD conflicts for users {see [0009]}.

**As for dep. claim 2 (part of 1),** the further limitation of carrying out the previous steps by a computer software program is taught on Fig. 1 "PC program" of ANDERSON et al.

**As for dep. claim 3 (part of 1),** the further limitation of addressing any conflicting task parameters, i.e. re-assigning task or lock out, this is fairly taught in page 3, paragraphs (1) -- (3).

**As for independent Apparatus claim 4,** which is basically the system to carry out the method of claim 1 above, with "means for" instead of "step of", it's rejected over the "means for" to carryout the equivalent step as shown in the rejection of claim 1 above.

**As for dep. claim 5 (part of 4),** with deals with the identifying conflicting tasks parameter, i.e. using a matrix, this is fairly taught in LUSA "page 2, (1) "organization chart", and ANDERSON et al as shown in {[0026 "separation of duties (SOD) matrix"]}.

**As for dep. claim 6 (part of 4),** with deals with the means for determining parameter, i.e. by comparing, this is inherently included in the process of ANDERSON

et al in view of [0026], [0043 "comparators" for comparing] in order to achieve the result of determining the "SOD conflict". Furthermore, this is also mentioned in LUSA on page 3, footnotes (3) and (4).

**As for independent Product claim 7,** which is basically the computer program product to carry out the method of claim 1 above, with "program code configured to" carry out the same step as in claim 1 above, it's rejected over the "program" to carryout the equivalent step as shown in the rejection of claim 1 above, see ANDERSON et al Fig. 1 "PC program", [0043, 0044].

**As for dep. claims 8-9 (part of 4),** which have similar limitations as in dep. claims 5-6 above, they are rejected for the same reasons set forth in dep. claims 5-6 above.

**12. Claims 1-3, 4-6, 7-9 are rejected (3<sup>rd</sup>) under 35 U.S.C. 103(a) as being unpatentable over LUSA, Article "1991 Network .. Block" of Mar. 1991, further in view of BAYNARD et al (US patent 6,738,746).**

**As for independent method claim 1,** LUSA fairly discloses a method for business controlling by determining conflicting assignments of tasks (duties; or activities) of a business process comprising:

- (c) dividing the business process into component tasks (activities, duties) on the computer {see page 3, see footnote (1), (2), (4)};
- (d) identifying for a component task any other component task that conflicts with the component task on the computer system {see page 3 footnotes (2), (3);

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(e) associating at least one component task with a person involved in the business process {see page 3, footnotes (3) and (4)};

(f) determining whether each associated component task is a conflicting task {see page 3, footnotes (1), (3) and (4)}. LUSA teaches the claimed invention except for steps (a), (b) and carrying out the steps using a computer system. In other word, LUSA teaches the claimed invention except for automating the steps using computer system. Since making automatic or automate from manual operation using computer system is an obvious modification to a an artisan, see In re Venner, 120 USPQ 192, CCPA 1958, it would have been obvious to automate the steps of LUSA using computer system, absent evidence of unexpected results. As for steps (a) and (b), these are inherently included when carrying out the invention of LUSA using a computer system.

In a similar process for controlling business by determining conflicting assignments of tasks (duties, or activities) of a business process including use of a computer system, BAYNARD et al teaches the use of inputting these steps into a computer system and generate a SOD matrix to identify conflicted assignment {see Fig. 2, col. 18, lines 50-67 or (c18:50-67), c19:1-5}. It would have been obvious to modify the process of LUSA by using computing system with independent programming tool as taught by BAYNARD et al for effectively analyzing business SOD conflicts for users {see col. 1, lines 25-45}.

As for dep. claim 2 (part of 1), the further limitation of carrying out the previous steps by a computer software program is taught on Fig. 2 of BAYNARD et al.

**As for dep. claim 3 (part of 1),** the further limitation of addressing any conflicting task parameters, i.e. re-assigning task or lock out, this is fairly taught in LUSA page 3, paragraphs (1) – (3).

**As for independent Apparatus claim 4,** which is basically the system to carry out the method of claim 1 above, with “means for” instead of “step of”, it’s rejected over the “means for” to carryout the equivalent step as shown in the rejection of claim 1 above.

**As for dep. claim 5 (part of 4),** with deals with the identifying conflicting tasks parameter, i.e. using a matrix, this is fairly taught in LUSA “page 2, (1) “organization chart”, and BAYNARD et al as shown in {col. 21, lines 1-5, “separation of duties (SOD) matrix”}.

**As for dep. claim 6 (part of 4),** with deals with the means for determining parameter, i.e. by comparing, this is inherently included in the process of BAYNARD et al in order to achieve the result of determining the “SOD conflict”. Furthermore, this is also mentioned in LUSA on page 3, footnotes (3) and (4).

**As for independent Product claim 7,** which is basically the computer program product to carry out the method of claim 1 above, with “program code configured to” carry out the same step as in claim 1 above, it’s rejected over the “program” to carryout the equivalent step as shown in the rejection of claim 1 above, see BAYNARD et al col. 1, lines 30-35, col. 2, line 63 to col. 3, line 20.

**As for dep. claims 8-9 (part of 4), which have similar limitations as in dep. claims 5-6 above, they are rejected for the same reasons set forth in dep. claims 5-6 above.**

***Response to Arguments***

13. Applicant's arguments with respect to claims 1-9 in paper of 2/16/2005 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703)872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
April 28, 2005

  
DEAN T. NGUYEN  
PRIMARY EXAMINER